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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/425,742 10/22/99 KRAEMER

K 02481.1641

EXAMINER

HM12/0917

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WELLS

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/425,742	KRAEMER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lauren Q Wells	1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____.                                   |

Art Unit: 1619

### **DETAILED ACTION**

Claims 1-8 and 10-29 are pending. Claim 9 is drawn toward nonelected subject matter and is therefore withdrawn from consideration.

#### ***Response to Applicant's Arguments/Amendment***

The Applicant's arguments filed August 16, 2001 (Paper No. 12) to the rejection of claims 1-8 and 10-29 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive. The rejection of claims 1-8 and 10-29 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive. Therefore, the said rejection is hereby withdrawn.

#### ***103 Rejection Maintained***

The rejection of claims 1-8 and 10-27 under 35 U.S.C. 103(a) as being unpatentable over Claussner et al. (6,087,509) or Claussner et al. (4,750,553) in view of Lai (5,916,910), Ismail (5,541,220), Galey et al. (WO 92/21317), Dumats et al. (WO 91/19701) and Estradier et al. (EP 427625) is MAINTAINED for the reasons set forth in the Office Action mailed May 16, 2001, Paper No. 11, and those found below.

Applicant argues that "nothing in Cretois motivates one to use any particular "antiseborrhoeic agents", let alone the particular compounds of either Claussner patent". This argument is not persuasive. In Col. 9, lines 35-46 Claussner ('509) teaches, and in Col. 14, lines 1-12 Claussner ('553) teaches formula (I) of the instant invention as a medicament for the treatment of cutaneous affections, such as hyperseborrhea, and in Col. 6, lines 36-44 Cretois teaches antiseborrhoeic agents in her composition.

Art Unit: 1619

Applicants further argue that “because the compounds of the Claussner patents possess anti-androgenic activity, one of ordinary skill in the art would not have been motivated to use the compounds of either ‘509 or ‘533 as Cretois’ “antiseborrheic agent””. This argument is not persuasive. Cretois places no limitation on compounds that are antiseborrheic agents. Thus, regardless of what the *Science of Hair Care* states, Cretois teaches the addition of antiseborrheic agents and Claussner and Claussner teach their compounds as antiseborrheic agents.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

Art Unit: 1619

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
August 24, 2001

  
DAMERON L. JONES  
PRIMARY EXAMINER